

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Jerome S. Golden

Application No.: 09/541,197

Confirmation No.: 4910

Filed: April 3, 2000

Art Unit: 3695

For: SYSTEM AND METHOD FOR PROVIDING
SECURE RETIREMENT BENEFITS VIA A
CONVERSION PROCESS

Examiner: S. E. Chencinski

REPLY BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

This Reply Brief is filed in response to the Examiner's Answer mailed December 31, 2008.

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I. STATUS OF CLAIMS

A. **Total Number of Claims in Application**

There are 38 claims pending in this application.

B. **Current Status of Claims**

1. CLAIMS CANCELED: 1-54,
2. CLAIMS PENDING: 55-93,
3. CLAIMS REJECTED: 55-93.

C. **Claims On Appeal**

The claims on appeal are claims 55-93.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The Examiner's Answer introduces a new ground of rejection under 35 U.S.C. § 101 against claims 80-93. Neither the final Office action nor the advisory action include any rejection under 35 U.S.C. § 101. Yet, the Examiner's Answer fails to designate this ground of rejection as a new ground of rejection under 37 C.F.R. § 41.39(b). Accordingly, the Answer fails to give Appellant the fair opportunity to amend the claims or submit new evidence in response to this new rejection. Appellant finds error in the new ground of rejection introduced in the Examiner's Answer of claims 80-93 under 35 U.S.C. § 101.

Appellant finds error in each of the claim rejections set forth in the final Office action and maintained in the Examiner's Answer, which are summarized as follows:

Claims 55, 59, 60, 68, 69, 75, 78, 79, 80 and 84 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of the following nine references:

- U.S. Patent 6,154,732 (Tarbox),
- U.S. Patent 6,205,434 (Ryan),
- Barron's Dictionary of Insurance Terms, 3rd Ed. (Barron's Insurance Terms),
- Barron's Dictionary of Finance and Investment Terms, Fifth Ed. 1995 (Barron's Finance and Investment Terms),
- U.S. Patent 5,704,045 (King),
- U.S. Patent 6,014,642 (El-Kadi),
- U.S. Patent 5,933,815 (Golden),
- U.S. Patent 6,275,807 (Schirripa), and
- U.S. Published Patent Application 2001/0014873 (Henderson).

The status of claims 70-74, 76, 77, 90, 92 and 93 is not clear.

Claims 56 and 81 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the nine references applied against claims 55 and 80 and further in view of U.S. Patent 5,523,942 (Tyler).

Claims 57 and 82 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the nine references applied against claims 55 and 80 and further in view of U.S. Patent 6,021,397 (Jones) and U.S. Patent 5,893,071 (Cooperstein).

Claims 58, 61-67, 83, 85-89 and 91 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the nine references applied against claims 55 and 80 and further in view of Jones.

III. ARGUMENT

A. Response to Rejection under Section 101

As noted above, the Examiner for the first time in the Answer asserts that claims 80-93 are rejected because the claimed subject matter is non-statutory subject matter under 35 U.S.C. § 101. The Examiner notes that claim 80 recites a process comprising the steps of allocating, calculating, recalculating and altering. The Examiner then asserts that that a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing. The Examiner asserts with no analysis that the method is not considered a patent eligible process under 35 U.S.C. § 101 since neither of these requirements is met by the claim. However, the Examiner utterly fails to address or even note that claim 80 sets forth a programmed computer that is required to perform the claimed method. Accordingly, the method of claim 80 is in fact tied to another statutory class of subject matter as required in the Answer.

The Examiner cites to four cases as authority for rejecting claims 80-93 as claiming non-statutory subject matter. However, none of these cases support a rejection of claim where a programmed computer is required to perform the claimed method. The U.S. Supreme Court has stated: “That a process may be patentable, irrespective of the particular form of the instrumentalities used.” *Cochrane v. Deener*, 94 U.S. 780, 787 (1876). The Court noted that process at issue in *Cochrane*, a method of bolting flour, was a series of acts “performed upon subject-matter to be transformed and reduced to a different state or thing.” *Id.* at 788. The Court did not state that a process must transform underlying subject matter to a different state or thing to be patentable, only that the process of bolting flour that did transform the flour was patentable. In fact, upon review of prior precedent, the Court has identified that in addition to processes that transform underlying subject matter to a different state or thing, processes that are tied to a particular machine or apparatus are also patentable. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972). The Court in *Benson* found that “[p]henomenon of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work.” *Id.* at 69. The Court held that due to the breadth of Benson’s claims that his patent “would wholly pre-empt the mathematical formula and in practical effect would be a patent on the algorithm itself.” *Id.* at 72. The Court has expanded the holding in *Benson* to set forth that a novel algorithm in combination with known elements is not

patentable. *Parker v. Flook*, 437 U.S. 584, 593-594 (1978). *Benson* and *Flook* are applications of the principle that laws of nature, natural phenomena, and abstract ideas are excluded from patent protection. *Diamond v. Diehr*, 450 U.S. 175, 185. Furthermore, in *Diehr* the Court concludes that “a claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula, computer program, or digital computer.” *Id.* at 187.

The Federal Circuit has recently considered the precedent relied upon in the Answer *en banc* in *In re Bilski*, 454 F.3d 943, 88 U.S.P.Q.2d 1385 (2008). The Court acknowledged: “The true issue is whether Applicants are seeking to claim a fundamental principle (such as an abstract idea) or a mental process.” *Bilski*, 454 F.3d at 952, 88 U.S.P.Q.2d at 1389. The court held: “A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” *Id.* 454 F.3d at 954, 88 U.S.P.Q.2d at 1391. In other words, the court found that where a claimed process is tied to particular machine or apparatus or transforms a particular article it does not pre-empt substantially all uses of a fundamental principle.

Claim 80 sets forth a method for planning for, implementing and administering a retirement benefit program. The claimed method takes funds from asset vehicle accounts and allocates the funds toward desired retirement benefits, such as annuities, over an allocation period specified by the owner of the accounts. Claim 80 expressly sets forth a programmed computer that is required to perform the claimed method. Claim 80 does not claim a fundamental principle or a mental process, rather it is directed to a detailed method of allocating funds from asset vehicle accounts toward desired retirement benefits over an allocation period. The Examiner identifies no fundamental principle that is pre-empted by claim 80. Claim 80 is not directed to a mental process as it is tied to a programmed computer that is required to perform the method. The Examiner in the rejection under 35 U.S.C. § 101, fails to address or otherwise recognize the programmed computer that is set forth by claim 80. As claim 80 is tied to a machine that is required to perform the claimed method and does not otherwise pre-empt a fundamental principle, claim 80 complies with the machine-or-transformation test set forth in *Bilski*. The Examiner has provided no analysis regarding why claim 80 is deemed not to comply with this test. Accordingly, the rejection under 35 U.S.C. § 101 of claims 80-93 is erroneous and

and should be reversed.

B. Response to Rejection under Section 103

1. EXAMINER'S FUNDAMENTAL MISUNDERSTANDING

Appellant is not claiming an automated system for practicing what has previously been done manually in the financial industry. To the contrary, Appellant claims specific and detailed systems and methods that implement financial products not previously known in the industry. The claimed invention provides the tools for an individual to conduct much of his or her own retirement planning. The systems and methods take funds from asset vehicle accounts and allocates the funds towards desired retirement benefits, such as annuities, over an allocation period specified by the individual. This is in marked contrast to prior retirement planning options. Prior to this invention, retirees and individuals investing for retirement have had access to an array of products such as mutual funds, life annuities, life insurance, long term care agreements, home equity loans, etc. However, the individual planning for retirement was forced to purchase each product such as an annuity or insurance product in separate distinct transactions, typically well before all the circumstances of the individual's retirement needs are fully known. Furthermore, each product is designed to address a particular need of the retiree, forcing the individual to address one need at a time. The instant invention overcomes these problems by providing for the allocation of funds from asset accounts towards the purchase of fractions of retirement benefits including a guaranteed life-dependent benefit, such as a life annuity, over the course of the allocation period. This approach permits the individual to adjust his or her retirement planning as circumstances change - an approach not possible in the past where individuals were forced to purchase separate benefits such as annuities in single transactions.

The general premise of the claimed invention raises several problems not addressed in the prior art. For example, given the flexibility to change the amount of funds converted to retirement benefits, an individual needs to be able to see the present value to the individual of the fraction of the benefit, such as an annuity, which has been purchased. This value is required as the individual manages the balance between investment return and risk to determine the optimum amount of assets to convert to a retirement benefit at any given time. Prior to this invention, there was no need or requirement to value a life-dependent benefit on a personal

actuarial basis. Annuities were valued by insurance companies and other financial institutions on a global statistical basis based on holding a multitude of annuities. There has been no suggestion in the industry to determine the present value of a purchased portion of an annuity to an individual on a personal basis. This is because the annuity has previously been purchased as a future benefit in a single transaction. However, when an individual purchases an annuity over an extended conversion period and has the ability to alter the desired future benefit as circumstances change, calculating the current individual value of the portion of the annuity purchased becomes desirable. The claimed invention provided a retiree with these opportunities. The claimed system and method thus includes calculating the value of a life-dependent benefit, such as an annuity, on an individual personal, actuarial basis. Such a calculation has not been required by prior retirement products and thus is not taught or suggested in the prior art.

The Examiner's Answer demonstrates that the prior art rejections are based on a fundamental misunderstanding of the claimed invention. The Examiner states: "Appellant's invention clearly delivers PREDICTABLE RESULTS, since it is merely an automation of a mechanical process involving well known actuarial calculations and recalculations." Ans. at 23. This statement is simply not true. Appellant's invention is not merely an automation of a mechanical process. As set forth above, prior to the invention set forth in the instant application, there were no processes, in either a manual or automated form, for allocating funds from asset accounts to retirement benefits over an allocation period. In fact there were no tools available for a potential retiree to value partially purchased individual retirement benefits, such as annuities, in order to methodically convert an asset into a retirement benefit. In other words, the claimed methods and systems were not known or obvious in any manual form that was automated by Appellant.

2. REQUIREMENTS OF SECTION 103

The Examiner's Answer relies on *Ex parte Catan*, 83 U.S.P.Q.2d 1569 (BPAI 2007) to explain a proper determination of obviousness under 35 U.S.C. § 103 in view of the decision by the Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).

In particular, the Supreme Court emphasized that "the principles laid down in *Graham* reaffirmed the 'functional approach' of *Hotchkiss*, 11 How. 248." *KSR*, 127 S.Ct at 1739, 82 USPQ2d at

1395 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12, 148 USPQ 459, 464 (1966) (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does more than yield predictable results.” *Id.*

* * *

The Court explained, “[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *Id.* at 1740-41, 82 USPQ2d at 1396. The Court noted that “[t]o facilitate this review, this analysis should be made explicit. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take into account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 1741, 82 USPQ2d at 1396.

Catan at 1573. This summary of the requirements for establishing obviousness under Section 103 makes clear that there must be an explicit analysis setting forth reasoning supporting the conclusion of obviousness. Appellant recognizes that the Examiner’s reasoning for combining references need not be found within the four corners of the cited prior art references, but rather can take into account the inferences and creative steps that a person of ordinary skill in the art would employ. However, where the Examiner’s reasoning consists of mere conclusory statements, rejections on obviousness grounds cannot be sustained.

The Examiner’s rejection cannot be sustained where numerous references are amassed to show various disparate claim limitations that are merely asserted to be well known in the art. There must be some articulated reason that one of ordinary skill in the art would have combined the teachings of the various references to arrive at the claimed invention.

“The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” M.P.E.P. § 2142 (8th Ed. Rev. 6, 2007). Accordingly, the examiner bears the initial burden to articulate reasoning with some rational underpinning to support the legal conclusion of obviousness. Mere conclusory statements that the prior art can be combined to render the claimed invention obvious are insufficient to shift the burden to Appellant to come forward with evidence or arguments of nonobviousness.

“When evaluating claims for obviousness under 35 U.S.C. § 103, all the limitations of the claims must be considered and given weight.” M.P.E.P. § 2143.03 II. Accordingly, a *prima facie* conclusion of obviousness must articulate reasoning why each limitation of the rejected claims is obvious in view of the applied prior art.

3. RESPONSE TO EXAMINER’S ARGUMENTS RAISED IN ANSWER

This section responds to Section (10) “Response to Argument” of the Answer. This section is organized according to the organization of Appellants arguments as set forth in Section (10) of the Answer.

a. Argument A

i. Points 1 and 2

Appellant asserted in the Appeal Brief¹ that none of the applied prior art, individually or collectively, discloses or suggests a retirement benefit program in which an individual manages the conversion of assets to guaranteed retirement benefits over an allocation period. Appellant has further asserted that none of the applied prior art discloses or suggests recalculating the current value and target benefit payment when the circumstances of the individual change.

The Answer fails to point out where any prior art reference teaches or suggests these claim limitations. Rather, the Examiner asserts the erroneous misunderstanding addressed above:

Common sense tells a practitioner that Appellant’s invention is merely a combination of well know elements in the art composed of well known financial and actuarial calculations. These well

¹ “Appeal Brief” is used throughout to refer to the Second Amended Appeal Brief filed October 10, 2008.

known steps were offered and performed for high net worth clients for decades and perhaps generations, done by hand, cobbling together increasingly repackaged pieces. Appellant's invention merely automates these well know steps and presents them as bundled, automated product.

Ans. at 23-24. As discussed above, there is no support for, nor truth in, the Examiner's assertion that the invention is composed of well known financial and actuarial calculations done by hand prior to Appellant's invention. The Examiner identifies no teaching or suggestion in the prior art of managing by hand the conversion of assets to guaranteed retirement benefits over an allocation period. The Examiner identifies no teaching or suggestion in the prior art of recalculating by hand the current value and target benefit payment when the circumstances of the individual change. As explained, above there was no need to make these calculations prior to the claimed invention. The Examiner's reasoning is based on the fundamental error that the claimed invention is the mere automation of well know manual steps performed for clients for decades.

ii. Point 3 - Reason to Combine

In the Appeal Brief, Appellant asserted that the Examiner has failed to articulate a reason to combine the applied references to arrive at the claimed invention. The Examiner responds that "[in] the instant case th[e] examiner has properly provided the motivation to combine the prior art references used in the rejections." Ans. at 25. This is the epitome of a mere conclusory statement which cannot sustain an obviousness rejection.

iii. Point 4

In the Appeal Brief, Appellant asserted: "Under the Examiner's reasoning, there can be no new non-obvious insurance or investment products because the mechanics of buying, selling and valuing insurance and investment products are known in the art." Appeal Brief at 18. The Examiner responds that he has made no such statement and would not support such reasoning. Ans. at 25. However, the Examiner has merely asserted that financial calculations and transactions were known at a very general level - such a general level that the Examiner relies on dictionaries to show "conversion." Ans. at 6. The Examiner then argues, without identifying in the prior art any of the specific calculations or transactions set forth in the instant claims, that it would have been obvious to an ordinary practitioner to have combined the disclosures of the

general teachings of the prior art to arrive at the specific claimed invention. Ans. at 8.

Appellant fails to see how the Examiner's reasoning could not be applied to reject claims to any new insurance or investment product. The rejections are asserted at such a fundamentally general level that they cannot properly demonstrate that the specific claimed invention would have been obvious to one of skill in the art.

iv. Subsidiary Argument (1)

In the Appeal Brief, Appellant noted that the Examiner relies on a CLU as an example of one of ordinary skill in the art. Appellant submitted evidence showing that a "CLU" is a Chartered Life Underwriter" and showing the educational requirement for becoming a CLU. Appellant noted that a CLU is trained to provide legally available products and service to clients. There is no suggestion that a CLU is trained to develop new financial systems or products. Accordingly, given the teachings of general financial calculation and products cited by the Examiner in the prior art, there is no reason that a CLU would use such teaching to attempt to create the new products and services of the instant claims. CLUs did not provide any service or product equivalent to the instant invention prior to the invention by Appellant, because prior to Appellant's embodiment of the invention there were no legally approved financial products that enabled a guaranteed life-dependent retirement benefit which included allocating a portion of funds from one or more personal financial assets towards purchasing fractions of a guaranteed life dependent retirement benefit. (Golden Decl. ¶ 9.) Appellant was in fact the first to obtain regulatory approval for an embodiment of the claimed invention. (Golden Decl. ¶ 7.)

The Examiner's response to this argument is that "a CLU would have known how to provide the product by hand based on the CLU knowledge requirements." Ans. at 27. Again, this argument is based on the Examiner's erroneous misunderstanding that a product equivalent to the claimed invention was provided by hand. The Examiner points to nothing in the curriculum requirements to achieve the CLU designation that suggests that claimed invention was previously performed by hand and nothing that suggests the specific limitations of the claimed invention. The Examiner's hollow argument is contradicted by the declaration of the Jerome Golden, the inventor, which explains that there were no equivalent products available for a CLU to offer client prior to the invention of the claimed subject matter. In response, the Examiner asserts: "Appellant's bold generalization that such products were not available is

therefore incorrect, since it only applies to Appellant's invention at the most detailed narrow level as an automated method and system." Ans. at 28. Again, there is no evidence to support the Examiner's contention that manual products that suggest the claimed invention were available prior Appellant's patent application.

v. Subsidiary Argument (2)

(1) General Error (2) – 1

In the Appeal Brief, Appellant asserted that the applied art does not show or suggest a method or system of implementing and administering a retirement benefit program including at least one guaranteed life-dependent retirement benefit that calculates total current value and target benefit payments at each allocation period as an asset vehicle is converted to a guaranteed life-dependent retirement benefit as set forth by claim 80. The Examiner responds:

The rejections of the independent claims, with claim 80 as exemplary, and as repeated above, show that the examiner has made a proper case of *prima facie* obviousness by presenting evidence from the prior art of Tarbox, Ryan, Barron's Dictionary of Insurance Terms, 3rd Ed., Barron's Dictionary of Finance and Investment Terms, Fifth Ed. . . . , King, El-Kadi, Golden, Schirripa and Henderson, combined with extensive rationale. This combination of evidence and rationale is further amplified with the additional rationale and evidence contained in the responses to the arguments contained in Appellant's Appeal Brief.

Ans. at 32. This is a mere conclusory statement that cannot support an obviousness rejection. The only rationale that the Examiner has advanced to support the rejections is that the claimed invention is the mere automation of previous manual operations. This assertion is not supported by the prior art and is incorrect. The Examiner fails to identify any additional rationale and evidence contained in the responses to the arguments contained in the Appeal Brief.

(2) General Error (2) – 2

In the Appeal Brief, Appellant asserted that the applied art does not show or suggest recalculating the current value and target benefit payments at intervals of the allocation period based on change information including a change to the retirement benefit program. The Examiner responds:

The examiner has presented a proper case of *prima facie* obviousness in rejecting this component of the independent claim elements through the combination of evidence and rationale in the rejections with is further amplified with the additional rationale and evidence contained in the responses to the arguments contained in Appellant's Appeal Brief.

Ans. at 32. This is a mere conclusory statement that cannot support an obviousness rejection. The Examiner fails to identify any additional rationale and evidence contained in the responses to the arguments contained in the Appeal Brief.

(3) General Error (2) – 3

In Appeal Brief, Appellant characterized the rejections as being based on a primary reference that the Examiner acknowledges does not included teaching or suggestion of many of the claim elements. However, Appellant does not argue that this is *per se* an error in the rejection of the claims. This characterization of the appealed rejections comprised a portion of the foundation used to demonstrate that the prior art as whole failed to suggest several claim limitations and to demonstrate that the Examiner provides no rational reason for combining the applied references to arrive at the claimed invention.

(4) General Error (2) – 4

In Appeal Brief, Appellant asserted that the Examiner fails to point out where the prior art teaches the step of “allocating at selected intervals of an allocation period in accordance with at least a first set of instructions an allocation of a portion of funds corresponding to at least one asset vehicle, containing one or more personal financial assets owned by the person, towards purchasing one or more fractions of at least a first guaranteed life-dependent retirement benefit that provides one or more income benefit payments to the person to gradually purchase the at least first retirement benefit during the allocation period.”

The Examiner appears to interpret this argument as an argument that the art “teaches away” from the proposed combination. Ans. at 35. If so, the Examiner misconstrues Appellant's position. The error that Appellant has identified in the above paragraph is that the prior art fails to teach recited limitations of the claimed invention. There is simply no teaching

in the prior to gradually purchase a guaranteed life-dependent retirement benefit at intervals of an allocation period.

vi. Subsidiary Argument (3)

In the Appeal Brief, Appellant asserted that the Examiner has failed to articulate an apparent reason why an ordinary CLU would combine the selected features of the applied references to achieve the calculations and recalculations that are set forth by claim 80.

In response, the Examiner baldly asserts:

The independent claims, such as method claim 80, only claim broad, general limitations. Calculations which are New and not obvious to the CLU are not claimed.

Ans. at 31. This a mere conclusory statement that cannot support an obviousness rejection. Appellant has identified several specific, new and non-obvious, limitations that the Examiner has failed to identify in the prior art. For example, there is no teaching in the prior art of a calculation of a current value of a portion of a retirement benefit purchased to date based on an individual, personal actuarial valuation of the benefit.

To support the above argument, Appellant cited evidence that a CLU at the time of the invention would have been unaware of any legally approved investment product that performs the calculations of the claimed invention. In response the Examiner asserts:

Actually, this assertion is actually an admittance to rationale placed on the record by the examiner that the products with which Appellant's invention is concerned must be legally approved and that being the case further establishes the likelihood that ordinary practitioners would know how to provide such products, especially as the type of product invention claimed by Appellant. This product after all is merely an automation of existing process well known and understood by CLU's and similarly qualified practitioners.

Ans. at 31. This argument relies on the erroneous misunderstanding by the Examiner that the claimed invention is merely an automation of existing processes. It is not. The Examiner has pointed to no equivalent existing manual processes in the prior art. The claimed invention includes transactions and calculations not known to CLUs or others skilled in the art prior the

commercial embodiment of the claimed invention introduced to the market by the inventor. As noted above, there is no teaching in the prior art of a calculation of a current value of a portion of a retirement benefit purchased to date based on an individual, personal actuarial valuation of the benefit.

vii. Subsidiary Argument (4) – Supporting Declarations

Appellants relies on the Declaration of the inventor Gerome Golden and of the Declaration of Larry Port in the Appeal Brief. The Examiner here presents no reason why these declarations should be excluded from the record. Accordingly, Appellant asserts that the evidence provided by these declarations must be considered by the Board.

The Examiner asserts that he has shown on the record why the these declarations fail to meet the requirements of the M.P.E.P. Ans. at 21. Further, the Examiner erroneously asserts that the Golden declaration has been invalidated on the record without a valid traversal. Ans. at 33. These statements are an inappropriate response to Appellant's brief. "An examiner's answer should not refer, either directly or indirectly, to any prior Office action without fully restating the point relied on in the answer." M.P.E.P. § 1207.02. The Examiner's failure to consider the declarations of record without setting forth reasons that they are deficient is reversible error.

The Examiner further notes that the Jerome Golden is the inventor of the Golden reference and of the presently claimed invention. The Examiner notes that this makes Jerome Golden an interested party in Appellant's application. However, the Examiner may not refuse to consider the Golden declaration on this basis. "An affidavit of an applicant as to the advantages of his or her claimed invention, while less persuasive than that of a disinterested person, cannot be disregarded for this reason alone." M.P.E.P. § 716.01(c) III. (citing *Ex parte Keyes*, 214 U.S.P.Q. 579 (Bd. App. 1982); *In re McKenna*, 303 F.2d 717, 97 U.S.P.Q. 348 (C.C.P.A. 1953)).

For the above reasons, Appellant submits that the Examiner's refusal to consider the arguments set forth in the Appeal Brief as to the significance of the submitted declarations is error.

b. Argument B

The Examiner acknowledges that Appellant has in the Appeal Brief provided “detailed arguments regarding each dependent claim and each independent claim.” Ans. at 21. The Answer does not respond in kind to these detailed arguments. Rather the Examiner asserts:

Appellant’s arguments concerning the independent claims are fundamentally based on the GENERAL ARGUMENTS above which the examiner has responded to in detail above and in the rejections above and on the record. The examiner’s responses to additional detail concerning the independent claims and the responses to arguments concerning the dependent claims are also contained in the above rejections and in the rejections on the record.

Ans. at 36. Appellants general arguments include 1) that the Examiner has failed to articulate a reason with some rational underpinning to combine the references in the manner suggested and 2) that the applied art utterly fails to teach multiple claim limitations even when combined as suggested by the Examiner. With regard to the second argument, Appellants notes that the detailed arguments point out numerous limitations in the independent and dependent claims that the Examiner has failed to identify in the prior art. The Answer fails to address these deficiencies in the rejections set forth in the final Office action. For the above reasons in combination with the reasons set forth in the Appeal Brief, Appellant maintains that the applied prior art fails to render claims 56-93 obvious.

C. Conclusion

This reply addresses the issues raised in the Examiner's Answer and supplements the Appeal Brief. The Examiner has asserted that the teachings of at least nine references are properly combined because the claimed invention is merely a combination of familiar elements according to a known method that does no more than yield predictable results. Appellant has shown above that the invention is not a combination of familiar elements. Furthermore, the Examiner has identified no known method for combining the relied upon teaching to arrive at the claimed invention. Appellant respectfully submits that the claims are patentable over the applied prior art for the reasons set forth in the Appeal Brief as supplemented above. Appellant requests that the outstanding rejections be reversed and that the Examiner be directed to allow this application.

Dated: February 13, 2009

Respectfully submitted,

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